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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/14/2005

Toshiki Nonaka

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EXAMINER

YEE, DEBORAH

ART UNIT

PAPER NUMBER

1793

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,989	Applicant(s) NONAKA ET AL.	
	Examiner Deborah Yee	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4 and 6 to 15 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 6, 7, and 10 to 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2009 has been entered.

Election/Restrictions

2. Claims 8 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 22, 2008.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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5. The proposed amendment “free from containing Co” clearly raises a new matter issue since no clear descriptive support exist in the original disclosure. Note that negative limitation recited in claim, which did not appear in specification as filed, introduces new concepts. Applicant submitted that support maybe found in the specification in Table 1, at page 16, wherein examples of the steels of the present invention do not contain Co but this is insufficient since the express exclusion of Co is not stated, see Ex parte Grasseli, 231 USPQ 393.

Response to Arguments

6. Applicant’s arguments filed January 13, 2008, with respect to the rejection(s) of claim(s) 1 to 4, 6 , 7 and 10 to 15 under 35 USC 103(a) as being unpatentable over Japanese patent 2001-234218 (“JP-218”) have been fully considered and are persuasive. Applicant’s newly amended claims recite steel sheet “without containing retained austenite” whereas JP-218 steel sheet requires the presence of retained austenite at 3 vol.% or more which contains at least 0.9% carbon, see claim 7. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Japanese patent 2003-105513.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1 to 4, 6, 7 and 10 to 15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over computer-generated English translation of Japanese patent 2003-105513 ("JP-513").

9. The English abstract and claims 1 to 13 of JP-513 disclose steel sheet having a composition with constituents whose wt% ranges overlap those recited by the claims; and such overlap establishes a prima facie case of obviousness because it would be obvious for one skilled in the art to select the claimed alloy wt% ranges over the broader disclosure of the prior art since the prior art teaches the same utility (hot dip galvanizing) and similar properties, such as high strength and elongation, see MPEP 2144.05.

10. In addition, JP-513 in claim 9 teaches steel having a microstructure comprising 70 to 97 vol.% ferrite and 3 to 30 vol.% of austenite and/or martensite which would suggest present invention microstructure comprising ferrite and martensite without containing retained austenite.

11. More specifically prior art steel examples A to J closely meet the claimed composition and when calculated, meet or closely meet claimed equation (1). Even though JP-513 does not teach equation (1) as recited by claim 1, such properties attributed to the equation are met by JP-513 (e.g. $TS \times EI \geq 21000$). Also it has been well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, see *In re Cooper and Foley*, 57USPQ117.

12. Similarly, prior art steel example contains 0.001% B within the range of 0.0005 to 0.002% B and when calculated, satisfies equation (2) with a value of $2.27 < 2.9$ as recited by claim 3.

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13. JP-513 in claims 3 and 7 recite steel additionally containing 0.001 to 0.2% V and 0.0001 to 1% Ca and REM that suggest claims 2 and 4, respectively.

14. JP-513 in claim 12 teaches hot rolling and/or cold rolling followed by hot dip galvanizing treatment which meets claims 6, 7 and 10 to 15.

15. Machine-English translation of JP-513 can be obtained by going to

http://www.ipdl.inpit.go.jp/homepage_e.ipdl

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner
Art Unit 1793

/DY/